

REMARKS

Applicants have amended claim 33-37 to correspond to the antecedent basis of claim 18. Minor grammatical amendments to claim 18 have been made for clarity purposes.

Claim Rejections under 35 U.S.C. § 112

Claims 33-37 were are rejected under 35 U.S.C. 112, second paragraph, for issues regarding antecedent basis for certain terms in the claims. The amendments to the claims made herein obviate these rejections. Accordingly, the applicants respectfully request reconsideration and withdrawal of these rejections.

3. Claim rejections under 35 U.S.C. § 103(a)

Claims 18-20, 28, 29, 33, 34, 37, and 38 were rejected under 35 U.S.C. 103(a) as being unpatentable over Elbashir *et al.* (The EMBO Journal, Vol. 20, No. 23, pages 6877-6888, 2001), in view of Matulic-Adamic *et al.* (US 5,998,203), Parrish *et al.* (molecular Cell, Vol. 6, pages 1077-1087, 2000), and Crooke (US 5,898,031). For the reasons described below, the applicants respectfully traverse.

The publications relied upon are not properly combinable. The underlying premise of this rejection is the unstated and unsubstantiated assumption that all nucleic acid technology is essentially the same and interchangeable. The Office has conflated antisense, ribozymes, and siRNA technology into “nucleic acid technology.” This is evident in the Office’s application of antisense and ribozyme technology of Crooke and Matulic-Adamic, respectively, to the siRNA technology of Elbashir et al. What is missing from the rejection and what represents a fatal flaw in it is any teaching to this effect evident in the prior art at the priority date of the present application. Simply put, no evidence has been proffered indicating that chemical modifications employed in antisense and ribozyme technology could be freely and without limitation used in the siRNA technology of Elbashir with a reasonable expectation of yielding an active and useful dsRNA construct. Yet, this is the basis of the present rejection.

At the priority date of the present application, those of ordinary skill in the art understood that there were different structural features of nucleic acids required for activity in each of antisense, ribozyme, and siRNA technologies because the mechanism of action of these nucleic acids differed in each. Significantly, the mechanism of siRNA had not yet been explored to the

extent that one of ordinary skill in the art understood or could predict the effect of various types and positions of chemical modifications on the activity of a double stranded nucleic acid molecule. Absent such information, the applicants respectfully submit that the present rejection amounts to nothing more than an assertion that the presently claimed constructs would be obvious to try. And it has been long recognized that the “obvious to try” standard is insufficient under 35 USC § 103.

If there are any questions or comments regarding this Response or application, the Examiner is encouraged to contact the undersigned attorney as indicated below.

Respectfully submitted,

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